

PATENT

Application No.: 09/613361
Attorney Docket No.: 96-140-C1**R E M A R K S**

Prior to entry of this Amendment:

- Claims 70-79 and 81-90 were pending in the present application
- Claims 70-79 and 81-90 stand rejected
- Claims 70, 73, 81, and 83 are objected to

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 70-79 and 81-91 will be pending
- Claim 91 will be added
- Claims 70, 73, 76-79, 81, 83 and 91 will be the only independent claims

A. Telephone Interview

We would like to thank the Examiner for the helpful telephone conversation held on May 10, 2005, with our representative. While no formal agreement was reached, we are grateful for the opportunity to discuss the present application with the Examiner.

We discussed Claim 70 in light of the Gregory and Foreman references.

A.1. Applicants: Combination of Foreman and Gregory does not appear to teach all the features of Claim 70

We stated that the asserted combination of Gregory and Foreman would not provide for a gift certificate including a certificate identifier that is different from an account identifier, in which the gift certificate does not include the account identifier.

We stated that we did not understand how the Examiner was relying upon the "security codes" of Foreman in rejecting Claim 70. We stated that the "security codes" did not appear to be able to provide for all of the features of Claim 70, even if combined with teachings of the Gregory reference.

We also stated that there was no evidence of record supporting any motivation to combine the Gregory and Foreman references in a manner that would provide for the specific features.

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A.2. Examiner: Claim 70 is not limited to wherein the account identifier does not appear on the gift certificate

In response, the Examiner stated that Claim 70 does not contain a limitation that the account identifier is not included on the gift certificate.

In the Interview Summary mailed May 12, 2005, the Examiner states: "The Examiner explained that the claim language was not clear that the account number is not on the gift certificate but that the gift certificate is linked to an account. Mr. Downs argued that the claim language is clear enough."

A.3. Applicants: Claim 70 expressly recites wherein the gift certificate does not include the account identifier

We wish to clarify that to extent Mr. Downs "argued that the claim language is clear enough," during the Telephone Interview Mr. Downs in fact referred the Examiner to the specific language of Claim 70: *said gift certificate not including said account identifier*.

We are grateful that the Examiner agreed during the Telephone Interview to consider this express limitation of Claim 70.

A.4. Examiner: Technology Center 3600 requires that preambles of all method claims recite "computer-implemented method" or "computerized method"

We stated that no preamble of any claim suffers from any informalities or requires correction, and the requirement to amend preambles to recite "computer-implemented method" or "computerized method" is improper.

The Examiner stated that she was told by someone at the PTO that this is a requirement in the 3600 Technology Center.

The Examiner stated that this had not been a requirement in her former group, the 2100 Technology Center.

The Examiner agreed to check with someone regarding the preamble of the method claims.

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The Examiner requires "correction" of "informalities" in all of the preambles of Claims 70, 73, 81, and 83. According to the Examiner: "The preamble of the claim should read 'A computerized method...:' or 'A computer-implemented method...:'." We disagree.

B.1. No "correction" is required—no "informalities" are present

There is nothing that requires correction in any of the preambles of any pending claim.

We do not understand why the current language must be corrected. The Examiner has not provided any specific reason why the present language of the preambles is incorrect or informal, but merely requires that it be changed. No preamble includes any typographical errors; the Examiner does not assert otherwise. Every preamble clearly identifies its respective claim as directed to the statutory class of a method or process; the Examiner does not assert otherwise.

The only basis indicated by the Examiner for the proposed language of "computerized" or "computer-implemented" is that during the Telephone Interview the Examiner stated that she was told by "someone" that this is a requirement for preambles in Technology Center 3600. We are not aware of any such requirement. We also are not aware that there are different requirements for preambles depending upon which Technology Center (e.g., 3600 vs. 2100) the PTO determines to send a particular application for examination.

We request that the objection be withdrawn. If the objection is not withdrawn, we request that the requirement be deferred until claims are deemed allowable.

B.2. Request for Clarification

We also respectfully request that the Examiner provide any memos or other PTO correspondence, training materials, references to the MPEP, or policy positions of any Technology Center of the PTO related to and in support of the Examiner's objection to the preambles. If the Examiner is unable or is unwilling to provide any further explanation of the objection or its basis, we respectfully request that the Examiner identify the individual(s) who instructed the Examiner to issue such an objection/requirement, so that we can speak with this individual and understand the nature and authoritative basis of the objection/requirement.

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C. Section 103(a) Rejection

All of the pending claims (Claims 70-79 and 81-90) stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,909,673 issued to Gregory ("Gregory"), and further in view of U.S. Patent No. 5,377,271 issued to Foreman et al. ("Foreman"). We respectfully traverse the Examiner's Section 103(a) rejection.

The Examiner has not established substantial evidence of record that would support a *prima facie* case of obviousness of any claim.

Specifically, there is no substantial evidence that

(i) would support any finding that all of the features of any claim are suggested by the cited references, alone or in any combination; or

(ii) would support any finding that a motivation existed at the time of invention to provide for all of the features of any claim.

C.1. Independent Claims 70, 73, 76, 77, 78, and 79

We respectfully submit that independent Claims 70, 73, 76, 77, 78, and 79 are not obvious in light of Gregory or Foreman, either alone or in combination.

No combination of the references teaches or suggests the subject matter of Claims 70, 73, 76, 77, 78, and 79 as a whole.

Specifically, no combination of the references could suggest all of the following features generally recited in each of Claims 70, 73, 76, 77, 78, and 79:

A. generating by a computer a certificate identifier

in which

(i) the generated certificate identifier corresponds to an account identifier

(ii) the corresponding account identifier is associated with a financial account

(iii) the generated certificate identifier is different from the corresponding account identifier; and

B. producing a gift certificate

in which

(iv) the produced gift certificate does not include the corresponding account identifier

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(v) the produced gift certificate includes thereon the generated certificate identifier described in (i)-(iii).

C.1.1. The References Do Not Disclose All the Limitations of Any of Independent Claims 70, 73, 76, 77, 78, and 79

C.1.1.1. Examiner's Asserted Factual Findings

As we best understand the rejection of independent Claims 70, 73, 76, 77, 78, and 79, the Examiner asserts the following to be true:

- a) Gregory discloses all of the features of each of Claims 70, 73, 76, 77, 78, and 79 *except said gift certificate not including said account identifier*; and
- b) Foreman discloses *said gift certificate not including said account identifier*.

[Office Action, page 3].

We dispute that Foreman discloses or suggests *a gift certificate not including said account identifier* as generally recited in Claims 70, 73, 76, 77, 78, and 79.

We do not necessarily agree that Gregory teaches all of the other features of Claims 70, 73, 76, 77, 78, and 79. We reserve for now any arguments against the Examiner's assertions with respect to Gregory; they are moot given the Examiner's failure to establish a *prima facie* case of obviousness even if those assertions are true.

C.1.1.2. Examiner's Evidence of *said gift certificate not including said account identifier*

With respect to Claims 70, 73, 76, 77, 78, and 79, the Examiner asserts: "Foreman teaches, *said gift certificate not including said account identifier* (col. 7, lines 3-19, fig. 9, and fig. 10 –shows security code numbers for the money order)." [Office Action, page 3].

The text of Column 7, lines 3-19 is provided here:

Most money order agents work with vendors who provide goods and services to the agent on a regular basis. Oftentimes for convenience and accounting purposes, vendor payments will be made with money orders. When a typical money order is purchased it is printed with a "dollar" amount and the payee line is left blank to be filled in by the purchaser. In the case of vendor payments, a blank payee line could result in the unauthorized negotiation of the money order by the vendor's representative. To prevent such unauthorized negotiation a plurality of vendor names may be stored in the memory 18 associated with the terminal 12. Thus,

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when a money order is issued for a vendor payment, the appropriately coded vendor name is downloaded to the memory 40 associated with the printer 20 and is printed on the payee line 80 on the blank money order form 24, as shown in FIG. 9.

As indicated at Column 4, lines 31-34:

FIG. 9 is a top view of the back side of a series of blank money order forms illustrating the placement of timing marks on the back of every fourth money order form

As indicated at Column 4, lines 35-37:

FIG. 10 is a top view of a printed money order form illustrating the printing of a logo and vendor's name and the payee blank on the preprinted form

C.1.1.3. The Examiner's Evidence is not Substantial Evidence

We note that nothing in the cited portion of Column 7, Fig. 9, or Fig. 10 appears to have anything to do with any "security code numbers for the money order." Fig. 9 is described as "the back side of a series of blank money order forms." No description of Fig. 10 suggests "security code numbers."

We have considered all of Foreman. There is some description in Column 7 with respect to Fig. 8 and a "security font 100" (lines 31-60), but this does not appear to have anything to do with a "security code number" or producing a gift certificate without an account identifier.

The terms "security code," "host security code," "agent security code," and "security code level," are used variously throughout Foreman, including in the Abstract, the Summary of the Invention, and particularly in Column 8 (lines 5-57). As we understand Foreman, various types of "security codes" may be required in the Foreman system for "purposes of internal control and operator security," to perform functions from the host computer 48 (after entering a host security code from the host computer), and to perform other various functions and reprogram fields (through use of an agent security code).

These "security codes" and "security levels" do not appear to suggest anything remotely related to financial accounts, identifiers for such accounts, or what types of information are or are not included on a produced gift certificate.

Thus, even if the Examiner is correct that Foreman shows "security code numbers for the money orders," that teaching would not provide for the feature the Examiner concedes is missing from Gregory: *said gift certificate not including said account identifier.*

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The Examiner has failed to establish substantial evidence that all of the features of any of Claims 70, 73, 76, 77, 78, and 79 were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of independent Claims 70, 73, 76, 77, 78, and 79.

C.1.2. No Motivation to Combine the Cited References

The Examiner must also show

(i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art and

(ii) that this properly supported combination or modification would provide for the specific features of the claimed invention.

C.1.2.1. Examiner's Asserted Factual Findings

The Examiner asserts: "It would have been obvious...to have [sic] gift certificate not include an account identifier and to modify in [sic] Gregory to have an internal controller and operator security that can be programmed for varying security levels." [Office Action, page 3].

C.1.2.2. The Examiner's Evidence is not Substantial Evidence of a Motivation to Provide Specifically for said gift certificate not including said account identifier

The Examiner does not cite any particular portion of Foreman in support of the asserted motivation.

We were able to identify the following sentence in Foreman: "For purposes of internal control and operator security, the control terminal 12 and printer 20 are controlled and the memories 18 and 40 associated therewith may be reprogrammed at varying security levels." [Column 8, lines 5-6].

The Examiner does not provide any rationale as to how reprogramming at "varying security levels," "security codes," or generally securing access of individuals to a money order dispensing system suggests modifying Gregory to provide specifically for *said gift certificate not including said account identifier*.

The operational security concerns addressed by the "security codes" of Foreman do not appear to have anything to do with *said gift certificate not including said account identifier*, or even financial accounts, identifiers corresponding to certificate identifiers, or what types of information are or are not included on a produced gift certificate.

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Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory: *said gift certificate not including said account identifier.*

The Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *said gift certificate not including said account identifier*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims 70, 73, 76, 77, 78, and 79.

For the reasons stated herein, we request that the Section 103(a) rejection of Claims 70, 73, 76, 77, 78, and 79 be withdrawn.

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Application No.: 09/613361
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Claim 71 depends from independent Claim 70. Claim 74 depends from independent Claim 73.

The Examiner has failed to establish a *prima facie* case of obviousness for any of Claims 71 and 74 for at least the reasons stated above with respect to independent Claims 70 and 73.

In addition, the Examiner has failed to establish substantial evidence of the additional limitations of Claims 71 and 74.

The Examiner asserts that Gregory teaches "wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party (col. 6, lines 18-22 and lines 31-39 and col., 8, lines 45-53)." [Office Action, page 3].

We traverse this assertion. The cited portions suggest nothing about whether any type of identifier (much less an identifier that identifies an account identifier) may be discerned from a certificate identifier by a third party.

To the contrary, as the portions teach printing account numbers on the instruments, the Examiner's evidence teaches away from the claimed subject matter of Claims 71 and 74 as a whole, which requires that an account identifier associated with a financial account is not included on a produced gift certificate.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims 71 and 74. We request that the Section 103(a) rejection of Claims 71 and 74 be withdrawn.

C.3. Claims 72 and 75

Claim 72 depends from independent Claim 70. Claim 75 depends from independent Claim 73.

The Examiner has failed to establish a *prima facie* case of obviousness for any of Claims 72 and 75 for at least the reasons stated above with respect to independent Claims 70 and 73. We request that the Section 103(a) rejection of Claims 72 and 75 be withdrawn.

We do not necessarily agree that Gregory teaches all of the additional limitations of Claims 72 and 75, as asserted by the Examiner (page 4). We reserve for now any arguments against the Examiner's assertions with respect to Gregory; they are moot given the Examiner's failure to establish a *prima facie* case of obviousness even if those assertions are true.

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Attorney Docket No.: 96-140-C1**C.4. Independent Claim 81**

We respectfully submit that independent Claim 81 is not obvious in light of Gregory or Foreman, either alone or in combination.

No combination of the references teaches or suggests the subject matter of Claim 81 as a whole.

Specifically, no combination of the references could suggest all of the following features generally recited in Claim 81:

producing a gift certificate

in which

- (i) the gift certificate includes a sixteen-digit certificate identifier determined by a computer,
- (ii) in which the included sixteen-digit certificate identifier is an alias of an account identifier
- (iii) in which the account identifier identifies a financial account, and
- (iv) in which the account identifier identifies a credit card account.

C.4.1. The References Do Not Disclose All the Limitations of Independent Claim 81**C.4.1.1. Examiner's Asserted Factual Findings**

As we best understand the rejection of independent Claim 81, the Examiner asserts the following to be true:

- a) Gregory discloses all of the features of Claim 81 except "the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account"; and
- b) Foreman discloses "the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account."

[Office Action, page 4].

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We dispute that Foreman discloses or suggests *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*, as recited in independent Claim 81.

We do not necessarily agree that Gregory teaches all of the other features of Claim 81. We reserve for now any arguments against the Examiner's assertions with respect to Gregory; they are moot given the Examiner's failure to establish a *prima facie* case of obviousness even if those assertions are true.

C.4.1.2. Examiner's Evidence of the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account

With respect to Claim 81, the Examiner asserts: "Foreman teaches, the gift certificate including a sixteen-digit identifier (col. 7, line 31 – col. 8, line 58), in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account (col. 8, lines 16-40)." [Office Action, page 4].

The text of Column 7, line 31 to Column 8, line 58 is provided here:

As a further security measure, the numeric amount 82 of the money order is printed on the form 24 in a specially programmed security font 100 as shown in FIG. 8. The font 100 includes diagonal lineations 102 between asterisks 104 used to fill space not occupied by numerals representing dollar amounts. The diagonal lineations 102 also extend between the last appearing spacing asterisk 104 and a negatively printed "\$" 106 which is defined not by printing the "\$" 106 but by printing the background surrounding the "\$" 106. Thus, where the other printed indicia appears dark on a light background the "\$" 106 appears light on a dark background immediately surrounding the "\$" 106.

Diagonal lineation 102 separates the "\$" 106 from the first numeral 108 of the dollar amount. The last numeral 108 of the dollar amount and the first numeral 110 representing the amount in cents is separated by a vertically printed abbreviation 112 of the word "dollars". The numerals 110 representing the amount in cents are approximately half the height of the numerals 108 representing the dollar amounts. Diagonal lineations 102 separate the numerals 110 representing the amount in cents and the area immediately below each of the numerals 110 representing the amount in cents. Immediately following the last numeral 110 in the cent amount is a vertically printed abbreviation 114 of the word "cents". The various characters and configuration of the security font 100 are very difficult, if not impossible, to alter, thereby substantially reducing the risk of alteration of the dollar amount printed on the form.

Referring now to FIG. 9, in the event a particular agent wishes to print its logo 140 on the money order form 24, the logo 140 is downloaded from the host or

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agent computer to the control terminal 12, which in turn downloads the logo 140 to the memory 40 associated with printer 20 for printing on the money order form 24. Following the initial download to the memory 40 the logo resides in the memory 40 indefinitely. There is no need to transmit the logo or other routinely printed graphical or alphanumeric information during each transaction. This feature significantly decreases the printing time of the dispenser.

For purposes of internal control and operator security, the control terminal 12 and printer 20 are controlled and the memories 18 and 40 associated therewith may be reprogrammed at varying security levels. Many of the functions and operations of the money order dispenser 10 may be reprogrammed and controlled only from the host computer 48. A host security code which is contained within the operating program stored in the memory 18 associated with the control terminal 12 must be entered from the host computer 48 to perform functions flagged with a host level security code.

Various other functions may be performed and fields reprogrammed through use of an agent security code. As the security risk lessens, or the particular need to access a function becomes user specific, the security code required to access the particular function will vary. Thus, there are five levels of security codes, with various privileges assigned each security level as defined within the operating program contained in the memory of the control terminal 12.

The five security code levels include the host level, which may be accessed only by the host computer 48; the agent level, which may be accessed by the agent through the agent's computer 42, and in most situations the host computer 48; the store level which may be accessed through the keyboard 14 at the particular store location and which may in most cases be accessed through the agent and host level security codes. In addition to the store security code, a manager security code allows access to various functions and programmable fields through the keyboard 14 of the control terminal 12 in each particular store. The manager's security code is limited, however, to that particular store. The fifth level of security code is the employee level having associated therewith the fewest number of privileges necessary for printing money orders.

The privileges associated with each security code level may be reprogrammed at varying levels of security, as defined in the program operating the control terminal 12. By way of example, an employee must enter an employee's security code before a money order will print. In the event an amount is entered into the control terminal 12 which exceeds a maximum transaction dollar limit for that particular location, a manager code must be entered to allow printing of the money order. A daily total dollar amount limit may only be reset at the host security level. Host phone numbers stored in the system which are used to dial the host computer to upload information to the host computer may be changed by host, agent, or at the store security level through the keyboard. Thus, the

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multilevel security codes further insure security of the money order dispenser 10 against tampering and issuance of counterfeit money orders.

C.4.1.3. The Examiner's Evidence is not Substantial Evidence

We note that nothing in the cited portions of Columns 7 and 8 teaches an identifier (of any type) having sixteen digits.

There is no hint of a gift certificate including a sixteen-digit identifier.

There is no hint of an identifier that is an alias of another identifier.

There is no hint of an identifier that is an alias of another identifier that identifies a financial account.

Accordingly, Foreman does not suggest anything remotely related to including on a produced gift certificate a sixteen-digit identifier that is an alias of an account identifier that identifies a financial account.

The Examiner has failed to establish substantial evidence that all of the features of Claim 81 were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 81.

C.4.2. No Motivation to Combine the Cited References

C.4.2.1. Examiner's Asserted Factual Findings

The Examiner asserts: "It would have been obvious...to have the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account and to modify in [sic] Gregory to have because such a modification would allow Gregory to have a special program generated security numerical indicia defined by a printed character on an unprinted background." [Office Action, page 4].

C.4.2.2. The Examiner's Evidence is not Substantial Evidence of a Motivation to Provide Specifically for a gift certificate including a sixteen-digit identifier that is an alias of an account identifier that identifies a financial account

The cited portions of Column 7 and 8 of Foreman discuss a "specially programmed security font 100 as shown in FIG. 8." [Column 7, lines 31-34]. The special security font may involve a "negatively printed '\$' 106 which is defined not by printing the '\$' 106 but by printing the background surrounding the '\$' 106." [Column 7, lines 38-40].

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We cannot be certain that this is what the Examiner is referring to as "special program generated security numerical indicia defined by a printed character on an unprinted background." We request clarification.

The motivation proposed by the Examiner seems related to how the amount of the described money order is presented in a way that would make it difficult to alter the amount. [See, e.g., Column 7, lines 57-60 ("The various characters and configuration of the security font 100 are very difficult, if not impossible, to alter....")].

The Examiner does not provide any rationale as to how the "security font," or deterring alteration of printed numbers on a money order in general, would suggest modifying Gregory to provide specifically for *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*, as recited in Claim 81. The security font or "numerical indicia" do not appear to have anything to do with

sixteen digits,
an identifier of sixteen digits,
a certificate identifier,
a certificate identifier of sixteen digits,
an alias of an account identifier,
an alias of an account identifier that identifies a financial account, or
including on a produced gift certificate a sixteen-digit certificate identifier that is an alias of an account identifier that identifies a financial account.

Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory.

The Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claim 81.

For the reasons stated herein, we request that the Section 103(a) rejection of Claim 81 be withdrawn.

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Application No.: 09/613361
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We respectfully submit that independent Claim 83 is not obvious in light of Gregory or Foreman, either alone or in combination.

No combination of the references teaches or suggests the subject matter of Claim 83 as a whole.

Specifically, no combination of the references could suggest all of the following features generally recited in Claim 83:

- A. generating, by a computer, an alias identifier
 - in which
 - (i) the alias identifier provides an indirect link to a financial account
 - (ii) the financial account is identified by an account identifier
 - (iii) the alias identifier is different from the account identifier, and
- B. producing a gift certificate
 - in which
 - the gift certificate includes the alias identifier described in (i)-(iii).

C.5.1. The References Do Not Disclose All the Limitations of Independent Claim 83**C.5.1.1. Examiner's Asserted Factual Findings**

As we best understand the rejection of independent Claim 83, the Examiner asserts the following to be true:

- a) Gregory discloses all of the features of Claim 83 except "generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient"; and
- b) Foreman discloses "generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the

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gift certificate including the alias identifier; and providing the gift certificate to a recipient."

[Office Action, page 4].

We dispute that Foreman discloses or suggests what the Examiner asserts.

We do not necessarily agree that Gregory teaches all of the other features of Claim 83. We reserve for now any arguments against the Examiner's assertions with respect to Gregory; they are moot given the Examiner's failure to establish a *prima facie* case of obviousness even if those assertions are true.

C.5.1.2. Examiner's Evidence of the Features Missing from Gregory

With respect to Claim 83, the Examiner asserts that Foreman teaches all of the missing features at Column 6, lines 26-47. [Office Action, page 5].

The text of Column 6, lines 26-47 is provided here (emphasis added):

Referring now to FIGS. 8 and 9, the blank money order forms 24 have a serial number 34 printed along a leading edge 36 of the form 24. A timing mark 38 is placed on the back of each money order form 24 falling in a predetermined numbered sequence in the fan folded bundle 50 of money order forms 24. The corresponding serial number 34 of the particular money order form bearing the timing mark must be evenly devisable by the number of the position location of the form in the bundle. In other words, if the timing mark 38 appears on every fourth money order form, the serial number 34 of the fourth money order form should be devisable by four. When the mark 38 is sensed by a sensing mechanism contained within the printer 20, the serial number 34 is read and a determination made whether it is devisable by the appropriate number. If not, printing of the money order will not occur and the sequence and alignment of the money order forms 24 must be checked by the operator of the dispenser 10. Thus, the timing marks 38 prevent the unauthorized removal of a blank money order form, which would result in an out of sequence serial number 34.

The Examiner also asserts: "a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered an alias identifier." [page 5].

C.5.1.3. The Examiner's Evidence is not Substantial Evidence

We note that the cited portion of Column 6 is directed to a description of how the Foreman system ensures that blank money order forms are printed in the proper sequence and that an unauthorized removal of a blank form could be detected.

The Examiner's interpretation of this passage is strained beyond reason.

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As we understand the Examiner's use of Foreman, the Examiner relies on the following rationale:

(i) blank money forms are provided in a "predetermined number sequence"; and

(ii) each blank money form has a serial number 34; and therefore it follows that

(iii) each blank money form has a "predetermined number sequence" that is an "alias identifier" of its serial number.

We dispute any such interpretation of Foreman. Clearly, the "predetermined number sequence" is the sequence of serial numbers "in the fan folded bundle 50 of money order forms 24." There is no alias nature in this teaching of Foreman; the numbers are one and the same. We dispute the Examiner's finding that a serial number in Foreman is an alias of or corresponds to itself.

Also, despite the Examiner's conclusory statement, there is no support for the Examiner's convenient assumption that "a predetermined number sequence...is considered an alias identifier" by one having ordinary skill in the art at the time of the invention. We submit the Examiner has employed impermissible hindsight based on the present disclosure to justify application of Foreman's process for detecting unauthorized removal of blank money order forms against the claimed subject matter.

The Examiner has failed to establish substantial evidence that all of the features of Claim 83 were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 83.

C.5.2. No Motivation to Combine the Cited References

For at least the reasons stated above with respect to the Examiner's interpretation of Foreman, we submit that the Examiner has not provided substantial evidence of a motivation in the prior art that would suggest the desirability of providing for all of the specific features of Claim 83 that the Examiner concedes are missing in Gregory.

The Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for all of the features of Claim 83. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 83.

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For the reasons stated herein, we request that the Section 103(a) rejection of Claim 83 be withdrawn.

C.6. Claims 82 and 84-90

Claim 82 depends from independent Claim 81. Claims 84-90 depend from independent Claim 83.

The Examiner has failed to establish a *prima facie* case of obviousness for any of Claims 82 and 84-90 for at least the reasons stated above with respect to independent Claims 81 and 83, respectively.

In addition, the Examiner has failed to establish substantial evidence of the additional limitations of various claims. Our silence with respect to assertions of the Examiner against limitations not discussed here is not to be interpreted as agreement. Again, we will address any such assertions in the future as necessary.

C.6.1. Claims 82 and 84

With respect to Claims 82 and 84, the Examiner asserts: "Gregory teaches, in which the gift certificate is for a single use (col. 5, line 56-col. 6, line 16).

We submit that the cited portion has nothing to do with how many times a produced gift certificate may be used, much less that a gift certificate is for a single use. In contrast, some embodiments of the present invention provide for wherein a produced gift certificate may be used only once (*e.g.*, for one transaction by a recipient).

The Examiner has failed to establish substantial evidence of *a gift certificate for a single use*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims 82 and 84. For the reasons stated herein, we request that the Section 103(a) rejection of Claims 82 and 84 be withdrawn.

C.6.2. Claim 88

With respect to Claim 88, the Examiner asserts that both Gregory and Foreman fail to teach *in which the financial account is a credit card account*.

The Examiner has not provided any evidence in support of the assertions with respect to Claim 88. The Examiner simply asserts that this would have been an obvious modification—"a design choice as a method of payment." [page 6]. We note that the Examiner's conclusory and pejorative description of a "credit card account as a method of payment" as a "design choice" is not evidence of obviousness. Invention requires design choice. The Examiner's designation of the

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feature as "design choice" thus appears to merely re-state that the feature is an obvious modification, without providing any evidentiary basis for that assertion.

The Examiner must then be relying upon either the Examiner's own knowledge or some other evidence not made of record for these assertions as to

- (i) what was known at the time of the invention, and
- (ii) the alleged desirability of modifying the combined Gregory and Foreman references to provide for the specific missing feature.

A *prima facie* case of obviousness requires substantial evidence of the Examiner's findings. We request that the Examiner specify for the record all evidence being relied upon in the rejection of Claim 88.

The Examiner has failed to establish substantial evidence of all of the features of Claim 88. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 88. For the reasons stated herein, we request that the Section 103(a) rejection of Claim 88 be withdrawn.

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Attorney Docket No.: 96-140-C1**D. Newly-Added Claim 91 is Patentable Over the Cited References**

Newly-added Claim 91 is patentable over Gregory and Foreman for at least the reasons presented herein.

Neither Gregory nor Foreman, alone or in combination, teaches or suggests producing a magnetic stripe card having an alias account number thereon, in which the alias account number is compatible with a credit card transaction processing system, as recited in new independent Claim 91.

The Examiner alleges, without any supporting evidence, that it would have been obvious to modify the Gregory system "to have a magnetic stripe card." We traverse this unsupported assertion.

We respectfully submit that new Claim 91 is allowable.

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E. Authorization to Charge Appropriate Fees & Petition for Extension of Time to Respond

We understand that a two-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Charge: \$225.00

Deposit Account: 50-0271

Order No.: 96-140-C1

Please credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

F. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,



Michael Downs
Attorney for Applicants
Registration No. 50,252
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax

July 28, 2005
Date